

REMARKS

In response to the final office action of December 7, 2004, applicant asks that all claims be allowed in view of the following remarks. Claims 1-49 are pending, of which claims 1 and 29 are independent claims.

Requirement for Information

The Office action required submission of information under 37 C.F.R. § 1.105 and noted, *inter alia*, particular interest is “information related to the field of endeavor or business practices used by applicant’s professional business ventures [and] where the claimed invention is an improvement, identification of what is being improved and identification of any use of the claimed invention known to any of the inventors at the time the application was filed.” See Office action mailed December 7, 2004 at page 3, line 18 to page 4, line 1. See e.g., Office action mailed December 7, 2004 at pages 2-4. As noted in the Office action, the present application is assigned to America Online, Inc. (AOL). Applicant understands the request for information to be a request for information about AOL’s CD packaging practices relative to the claimed subject matter of the present application.

Prior to the filing date of the present application, AOL mailed a compact disk case that included a viewing window that exposed a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in claim 1 of the present application. However, applicant’s representative is not aware of any such mailings more than one year prior to the filing of the present application.

Moreover, prior to the usage of a compact disk case that included a viewing window that exposed a portion that is less than all of the surface of a disk inserted into the compact disk case, AOL packaged a compact disk by shrink wrapping the compact disk to a cardboard card. Shrink wrapping a compact disk to a cardboard card generally involved placing the compact disk on a cardboard card and covering the compact disk and cardboard card with a transparent covering. Examples of the compact disk shrink wrapped to a cardboard card appear to be shown in some of the images on page 1 of 4 to page 3 of 4 of www.brainblips.com/aol/aol5.0html provided with the Office action.

Also prior to the usage of a compact disk case that included a viewing window that exposed a portion that is less than all of the surface of a disk inserted into the compact disk case, AOL also packaged a compact disk in a DVD Box that did not have a window. Examples of the DVD box appear to be shown in some of the images on page 4 of 4 of www.brainblips.com/aol/aol5.0html.

Applicant asserts that this constitutes a complete reply to the information request.

Rejection of Claims 1-49 Under § 102

Claims 1-49 were rejected under 35 U.S.C. § 102 as being anticipated by AOL's CD package as indicated in the article AOL Virtual Museum, www.brainblips.com/aol/aol5.0html and AOL Virtual Museum, www.brainblips.com/aol/aol_canada.html (hereinafter AOL). Applicant requests reconsideration and withdrawal of this rejection because the AOL reference is not statutory prior art under § 102 for any of the claims in the present application.

The application was filed on December 29, 2000 and claimed the benefit of Provisional Application No. 60/236,350 that was filed on September 29, 2000. The Notice of References cited provided with the Office action of December 7, 2004 did not include a date for either AOL Virtual Museum, www.brainblips.com/aol/aol5.0html and AOL Virtual Museum, www.brainblips.com/aol/aol_canada.html. The AOL reference indicates a date of "12/20/01" on page 1 of 2 of www.brainblips.com/aol/aol_canada.html and a date of "12/19/2001" on page 1 of 4 of www.brainblips.com/aol/aol5.0html. Thus, since the AOL reference was published after the filing date of the present application, it cannot constitute anticipatory prior art.

Assuming for the sake of argument only that the AOL reference is statutory prior art under § 102 for any of the claims in the present application, applicant now responds to the subject matter of the § 102 rejection. The AOL reference appears to show America Online's packaging practices prior to the subject matter disclosed in the present application, as described previously in applicant's response to the request for information. The images shown in the AOL reference appear to show a cardboard mailer (that presumably contained a compact disk), a compact disk shrink wrapped to a cardboard card, or a DVD box (that presumably contained a compact disk). As such, none of the images included in the AOL reference disclose a compact

disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claims 1 and 29.

With regard to amended independent claim 1, a compact disk case is recited that includes, *inter alia*, a first side that is structured and arranged to define a viewing window that constitutes less than all of the first side to provide a first viewing characteristic that differs from a second viewing characteristic that is provided through another portion of the first side. The viewing window exposes a portion that is less than all of the surface of a disk inserted into the compact disk case.

The AOL reference appears to show some images of a cardboard mailer (that presumably contained a compact disk). As such, the AOL reference does not disclose a compact disk case, much less a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claim 1.

In another aspect, the AOL reference appears to show a compact disk that is shrink wrapped to a cardboard card. See the AOL Reference at page 1 of 4 to page 3 of 4 of www.brainblips.com/aol/aol5.0html. The AOL reference discloses adhering the compact disk to a cardboard card using transparent plastic wrap. As such, the AOL reference does not disclose a compact disk case, much less a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claim 1.

In yet another aspect, the AOL reference appears to disclose a DVD Box that did not have a window or labeled applications. Examples of the DVD box appear to be shown on page 4 of 4 of www.brainblips.com/aol/aol5.0html. As such, the AOL reference does not a compact disk case having a viewing window that exposes a portion that is less than all of the surface of a disk inserted into the compact disk case, as recited in the independent claim 1.

For at least these reasons, application requests reconsideration and withdrawal of the rejection of claim 1 and claims 2-28, which depend directly or indirectly from claim 1.

With regard to independent claim 29, claim 29 recites a method of distributing marketing materials stored as data on compact disk in a case having substantially the same features as recited in claim 1.

For at least the reasons described above with respect to claim 1, applicant requests reconsideration and withdrawal of the rejection of independent claim 29 and claims 30-49 that depend on claim 29.

Rejection of Claims 1-23 and 29-44 Under § 103

Claims 1-23 and 29-44 were rejected under 35 U.S.C. § 103 as being unpatentable over Flores (U.S. Patent No. 6,454,090) in further view of the AOL reference. Applicant requests reconsideration and withdrawal of this rejection. As discussed above, the AOL reference is not prior art to the present application, and thus, the proposed combination does not constitute prior art under § 103. For this reason, the rejection should be withdrawn.

In addition, on the merits, Flores does not describe or suggest a compact disk having first side that includes a viewing window that constitutes less than all of the first side. More particularly, Flores describes a compact disk storage case where the entire first side “comprises a transparent window 116 such that either the cover or a front page of the pamphlet, brochure, booklet or the like may be viewed when the disc storage container is closed.” See Flores at col. 7, lines 8-13 and FIG. 6, element 116. As such, Flores does not describe or suggest a first side of the compact disk case that includes a viewing window that constitutes less than all of the first side. Because the viewing window of Flores constitutes the entire first side of the compact disk case, this viewing window only provides one viewing characteristic. See Flores at col. 7, lines 8-13 and FIG. 6, element 116. This is because Flores merely describes a first side of the case that “comprises a transparent window” through which “either the cover or a front page of [a] pamphlet, brochure, booklet or the like” may be viewed. See Flores at col. 7, lines 9-13 (emphasis added). Since Flores only contemplates viewing one item at a time (either the cover or the front page of a booklet) through a single viewing window, the viewing window does not provide a first viewing characteristic that differs from a second viewing characteristic. Accordingly Flores does not describe or suggest a viewing window that provides a first viewing characteristic that differs from a second viewing characteristic provided through another portion of the first side.

Moreover, Flores' disk storage case exposes for viewing all of the surface of the disk. Thus, Flores does not describe or suggest a compact disk case having a viewing window that

exposes a portion that is less than all of a surface of a disk inserted into the compact disk case, as recited in claims 1 and 29.

For at least these reasons, applicant respectfully request withdrawal of this rejection of independent claims 1 and 29 and their dependent claims 2-23 and 30-44.


Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fee is believed due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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Barbara A. Benoit
Reg. No. 54,777

Customer No.: 26171
Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331